

REMARKS

The Examiner rejected independent Claim 1 as being obvious in view of the combined teachings of the Finley et al., Bainbridge et al., and Lemieux et al. references. This rejection is respectfully traversed.

At the outset, it is again urged that the Bainbridge et al. reference is clearly non-analogous art to the claimed invention. Therefore, the disclosure of the Bainbridge et al. reference should not be considered at all when evaluating the patentability of the claimed invention.

As set forth in Section 2141.01(a) of the MPEP, a reference must either be (1) in the field of the applicant's endeavor or (2) reasonably pertinent to the particular problem with which the inventor was concerned. With respect to the latter test, a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

With respect to the first leg of this test for analogous art, the field of the Bainbridge et al. reference (namely, protective padding for sports gear) is quite different from the field of the claimed invention (namely, acoustic underlayments for flooring). Thus, the field of the Bainbridge et al. reference is clearly not within the field of the claimed invention.

With respect to the second leg of this test for analogous art, the problems addressed by the Bainbridge et al. reference (namely, the challenges of providing a padding that can repeatedly absorb and dissipate impact forces, while still being lightweight, breathable, washable, and easily integrated into sports gear and not unduly inhibiting an athlete's movements and dexterity on the field) are quite different from the problems addressed by the claimed invention (namely, the issues of sound absorption, low sound transmission, and moisture control). Thus, the Bainbridge et al. reference is clearly non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention.

The Examiner stated that the Bainbridge et al. reference was reasonably pertinent to the particular problem with which the applicant was concerned, namely, "an acoustic padding layer of a closed-cell foam material." This statement is simply incorrect. The Bainbridge et al. reference has nothing at all to do with "acoustic" padding layers. The Examiner is requested to provide explicit support in the Bainbridge et al. reference for this proposition. Rather, as discussed above, the problem faced in the Bainbridge et al. reference is padding that can repeatedly absorb and dissipate impact forces, while still being lightweight, breathable, washable, and easily integrated into sports gear and not unduly inhibiting an athlete's movements and dexterity on the field. The Examiner's conclusion is only possible through the improper use of hindsight, which is clearly contrary to accepted law.

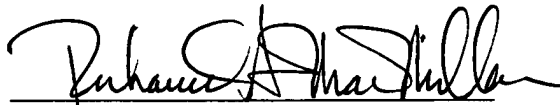
The Examiner further noted that the Bainbridge et al. reference discloses several other applications for the material disclosed therein (namely, that "the padding of the present invention has been primarily disclosed as adapted for use in sports gear but it is equally adaptable for use wherever foam and other padding are used. For example, the padding technology of the present invention could be used as pads for fences, poles, trees, and walls as well as in industrial applications such as elevators and vehicle bumpers." However, the use of the Bainbridge et al. padding in fences, poles, trees, walls, elevators, and vehicle bumpers is still well beyond the narrowly defined scope of the claimed invention, namely a multi-layered flooring composite. Thus, the Bainbridge et al. reference is clearly non-analogous art to the claimed invention and, therefore, should not be considered at all when evaluating the patentability of the claimed invention.

However, even if the disclosure of the Bainbridge et al. reference is properly considered, it cannot be reasonably combined with the disclosure of the Finley et al. reference, as proposed by the Examiner. The Examiner stated that it would have been obvious to combine the teachings of those two references "to provide a flooring surface that is resilient and durable for such activities as sports." This statement is clearly untenable. The Examiner suggests that the Bainbridge et al. material can be used in the

Finley et al. floor covering underlayment because (1) the Bainbridge et al. material is intended for use in sports equipment and (2) the Finley et al. floor covering underlayment could be used for sports activities. Such a rationale has no basis in fact and, therefore, clearly unsupportable. Thus, the rejection should be withdrawn.

The same arguments for patentability apply to independent Claims 31 and 45 in the application, which are also patentable for the same reasons. Thus, it is believed that the application is in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Richard S. MacMillan', written over a horizontal line.

Richard S. MacMillan

Reg. No. 30,085

MacMillan, Sobanski & Todd, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, Ohio 43604
(419) 255-5900